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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,988	09/12/2003	Shek Fai Lau	112440-712	9331

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EXAMINER

CHIESA, RICHARD L

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,988

Applicant(s)

LAU ET AL.

Examiner

Richard L. Chiesa

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9-12-03 & 11-8-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed on November 8, 2004 has been entered.

Drawings

2. The drawings filed on September 12, 2003 are accepted by the examiner.

Claim Objections

3. Claims 20 and 22 are objected to because of the following informalities: Claims 20 and 22 appear to be exact duplicates of one another. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1724

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,350,417. Although the conflicting claims are not identical, they are not patentably distinct from each other because the omission of the term "electro-kinetic transporter" in the claims of the present application appears to be a matter of semantics. This is because the claims of the present application as in the patented claims do not recite any fan or other air pumping equipment. Therefore, the air is moved by electro-kinetic effects in the devices of both the present application and the patent.

Claim Rejections – 35 USC 112

6. Claims 2-4, 9, 12-14, and 23-25 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, the reasons for this rejection are: (A) Claims 2-4, 12-14, and 23-25 are somewhat vague due to the presence of the phrase “wire-like” in claims 2, 3, 12, 13, 23, and 24. It would appear that this phrase should be changed to --wire--. (B) Claim 9 is ambiguous because the phrase “collector second” on the second line should apparently be changed to --said collector--.

Claim Rejections – 35 USC 102/103

7. The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless--
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103(c) and potential 35 USC 102(f) or (g) prior art under 35 USC 103(a).

10. Claims 20, 22, 27, 28, and 32 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over U.S. Patent No. 1,469,275 to Moller et al. Moller et al (note Figures 1-4) show a first electrode 2, and a movable second electrode 8, 9 with an attached electrically non-conductive cleaning member 25 (note second page, lines 11-28) as claimed (35 USC 102b). It would appear that Moller et al may not explicitly that their device is an air conditioner or has a housing. However, Moller et al do apparently show some sort of enclosure in Figure 1 and disclose that gases are treated (note first page, lines 49-53). Consequently, it is inherent or at least would have been obvious to one having ordinary skill in the art (35 USC 103a) to employ the Moller et al gas purification apparatus in a housing and to condition air.

11. Claim 26 is rejected under 35 USC 103(a) as being unpatentable over Moller et al in view of U.S. Patent No. 5,183,480 to Raterman et al. Moller et al, as described above in paragraph 10, disclose an electrostatic air conditioner substantially as claimed.

Apparently, Moller et al may not explicitly disclose a high voltage generator. In any case, Raterman et al (note col. 3, lines 54-63) teach the well-known use of a high voltage generator in an electrostatic air conditioner for the purpose of improving efficiency without sparkover. Therefore, it would have been obvious to one of ordinary skill in the art to employ a high voltage generator in the Moller et al air conditioner in order to improve efficiency as taught by Raterman et al.

Allowable Subject Matter

12. Upon the filing of a proper terminal disclaimer, claims 1, 5-8, 10, 11, 15-19, 21, 29-31, and 33-39 would be allowable.

13. Upon the filing of a proper terminal disclaimer, claims 23-25 would be allowable if rewritten to overcome the rejections under 35 USC 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. Upon the filing of a proper terminal disclaimer, claims 2-4, 9, and 12-14, would be allowable if rewritten to overcome the rejections under 35 USC 112 set forth in this Office action.

15. As allowable subject matter has been indicated, applicants' reply must comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP section 707.07(a).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references have been cited as art of interest to show other electrostatic air conditioners.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (571) 272-1154.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane S. Smith, can be reached at (571) 272-1166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (571) 272-1700.

Facsimile correspondence must be transmitted through (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard L. Chiesa
November 9, 2005

Richard L. Chiesa
RICHARD L. CHIESA
PRIMARY EXAMINER
ART UNIT 1724

Nov. 9, 2005